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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,762	09/03/2003	Donald J. Algrim	IN-5633CP	6912
26922	7590	11/02/2005	EXAMINER	
BASF CORPORATION			ROBERTSON, JEFFREY	
ANNE GERRY SABOURIN				
26701 TELEGRAPH ROAD			ART UNIT	PAPER NUMBER
SOUTHFIELD, MI 48034-2442			1712	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/654,762	ALGRIM ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jeffrey B. Robertson	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 August 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4 and 6-19 is/are rejected.
- 7) Claim(s) 5 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>0903, 0404</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-4 and 6-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 and 8-16 of U.S. Patent No. 6,897,265. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 8, and 13 of the '265 patent contain the required polyester compositions with hydroxyl numbers that significantly overlap those claimed in claims 1, 9, 10, 15, and 16 of the instant application. The requirement of isophthalic acid in the '265 patent is encompassed by the claims of the instant application and set forth in claim 8 of the instant application. Claims 2-4, 6, 7, 11-14, and 17 of the instant application correspond to claims 2-6, 9-12, and 14-16 of the '265 patent.

***Specification***

3. The disclosure is objected to because of the following informalities: the specification is missing a reference to the parent application 10/282,843, now U.S. Patent No. 6,897,265.

Appropriate correction is required.

***Allowable Subject Matter***

4. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter: Toman et al. (U.S. Patent No. 4,968,775) is cited as an X reference on the international search report. However, this reference does not teach or suggest the present claims. Specifically, Toman does not teach or suggest the required two polyesters or the presence of a first polyester that has a hydroxyl number of at least about 80 mg KOH/g polyester.

Yamada et al. (U.S. Patent No. 4,734,467) and Yamada et al. (EP 0 257 144 A1, cited on International Search Report) are the closest prior art references.

Both these references teach a coil coating composition containing a branched polyester (applicant's first polyester), a linear polyester (applicant's second polyester), and a crosslinking agent. In Table 1, Synthetic Example 6, Yamada teaches a branched polyester corresponding to applicant's first polyester. This polyester has a

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branched diol, neopentyl glycol, a flexibilizing diol, 1,6-hexanediol, and a polyol having at least three hydroxyl groups, trimethylol propane. This polyester has an aromatic dicarboxylic acid component isophthalic acid. This polyester has a hydroxyl number of 91, which is within the range claimed by applicant. In Table 1, Example 5, Yamada teaches a linear polyester corresponding to applicant's second polyester. This polyester has a branched diol, neopentyl glycol and a flexibilizing diol, 1,6-hexanediol and an aromatic dicarboxylic acid component isophthalic acid. This polyester has a hydroxyl number of 94, which is within the range claimed by applicant. Although the individual components are set forth by the references in these particular examples, there is no teaching or suggestion to combine these particular components. In addition, the references teach away from such a combination. Specifically, both of the hydroxyl numbers of these polyesters are over 90. These references require that the hydroxyl number be from 40 to 90. Therefore, there would be no motivation to combine the particular two components that fall within applicant's definitions because each has a hydroxyl number over 90, and the resulting composition would have a hydroxyl number of over 90. Since the reference does not teach or fairly suggest the general requirements of each individual polyester, the claims are allowable over the prior art.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Piana (U.S. Patent No. 5,739,204) and Moens et al. (U.S. Patent No. 6,660,398) are cited for general interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey B. Robertson  
Primary Examiner  
Art Unit 1712

JBR